

**Remarks**

Prior to the entry of this Amendment, the Application included claims 1-4, 6-13 and 17. No claims have been amended, canceled or added. Hence, after entry of this Amendment, claims 1-4, 6-13 and 17 stand pending for examination.

Claim 1 stands rejected under 35 U.S.C. 112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter of this invention.

Claims 1-4, 6-13 and 17 stand rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over U.S. Patent Application Publication No. 2002/0120846 to Stewart (“Stewart”), in view of U.S. Patent Application Publication No. 2003/0217003 to Weinflash (“Weinflash”).

**§112 Rejection**

Claim 1 stands rejected as allegedly being indefinite under §112 for failing to particularly point out the subject matter the Applicant regards as the invention. Specifically, the Office Action states that the recitation “the non-participant institutions are entities that are capable of supplying account-owner data, but are not obligated to provide account-owner data to the account-owner verification database and that are unable to access the account-owner verification database” is indefinite. *Office Action*, ¶3. The Applicant respectfully traverses the rejection.

Paragraph 28 of the application states that “non-participant data elements 36 may be obtained in the form of check printer data. Although not an account holding institution such as a traditional bank, a check printer nonetheless has access to accurate financial account information, albeit on a limited scale in comparison to account information available to an actual participant institution 12.” *Application* ¶28; *see also, id.*, at ¶32. By way of example only, consider the following situation: a customer deposits a check drawn on a non-participant institution into an account held by a participant institution. Based on whether the non-participant institution funds the check, the participant institution may learn certain information about the

account at the non-participant institution, such as whether the account number is valid and whether it contains sufficient value to fund the check.

Therefore, while these non-participant institutions cannot access the account-owner verification database, and are not *obliged* to provide account-owner data to the database, these entities are *capable* of supplying account-owner data. For at least this reason, Applicant maintains that the recitations of claim 1 are not indefinite, and respectfully requests withdrawal of the §112 rejection.

### **§103 Rejections**

All claims stand rejected as allegedly obvious over Stewart in view of Weinflash. Applicant respectfully traverses each rejection because *Weinflash does not qualify as prior art*. At the time of invention, both Weinflash and the instant application were subject to a duty to assign to the same entity: Primary Payment Systems. The cover sheet of Weinflash clearly indicates: “Assignee: Primary Payment Systems, Inc. *Weinflash*, coversheet. Further, a search of assignments on PAIR reveals that the instant application was also assigned to Primary Payment Systems, Inc., attached as **Exhibit E**. With both applications assigned to the same entity, a brief procedural analysis reveals no avenues through which Weinflash may gain admittance as prior art:

1. Weinflash was not published more than one year before the instant application was filed. Therefore, *Weinflash does not qualify as §102(b) prior art*.
2. While Applicant acknowledges that Weinflash was filed prior to the instant application, *Weinflash does not qualify as §102(e) prior art* because at the time of invention “the claimed invention was...subject to an obligation of assignment to the same person.” 35 USC §103(c). Both Weinflash and the instant application were subject to assignment to Primary Payment Systems, Inc. at the time the claimed invention of the instant application was made.

Therefore, Weinflash cannot qualify as prior art under §102(b) or §102(e).

To qualify as prior art under §102(a), Weinflash must be published before the date of invention of the instant application. Weinflash was published on November 20, 2003. The instant application was filed on February 6, 2004. However, Applicant hereby submits a §1.131 declaration signed by Glen Sgambati proving that the claimed subject matter of the instant application was conceived and pursued diligently since at least before November 20, 2003. The attached declaration of Glen Sgambati introduces Exhibits A-D, which prove that Sgambati had possession of the invention at least prior to November 20, 2003. Specific portions of the exhibits have been redacted to protect privacy and obscure materials irrelevant to conception of the claimed invention.

As an example of how the exhibits support the claims, claim 1 has been diagrammed below. Each element of claim 1 has been linked to at least one specific portion of an exhibit showing support.

*Claim 1*

<b>Claim Element</b>	<b>Support from Exhibits</b>
A method of populating and using an electronic account-owner verification database comprising:	<i>Exhibit B</i> , p. 3, ¶3 – p. 4, ¶1; <i>Exhibit C</i> , p. 3, ¶¶1, 2; <i>Exhibit A</i> , p. 1.
(a) receiving account-owner data elements linked to accounts maintained at at least one participant institution and at least one non-participant institution, each account-owner data element also corresponding to a data element field in the database, wherein:	<i>Exhibit B</i> , p. 3, ¶ 4 – p. 4, ¶2 ; <i>Exhibit C</i> , p. 3, ¶¶2, 3.
the participant institutions are entities that provide account-owner data linked to accounts maintained at both the participant institutions and non-participant institutions to the database	<i>Exhibit B</i> , p. 3, ¶ 4; <i>Exhibit C</i> , p. 3, ¶2; p. 5, ¶1; <i>Exhibit A1</i> , p. 1.

on a regular basis,	
the participant institutions are entities that are obligated to provide account-owner data to the account-owner verification database, and	<i>Exhibit B</i> , p. 3, ¶ 4; <i>Exhibit C</i> , p. 3, ¶2; p. 5, ¶1.
the non-participant institutions are entities that are capable of supplying account-owner data, but are not obligated to provide account-owner data to the account-owner verification database and that are unable to access the account-owner verification database;	<i>Exhibit B</i> , p. 4, ¶ 2; <i>Exhibit C</i> , p. 3, ¶3.
(b) receiving data elements from a plurality of check images corresponding to a plurality of checks, wherein:	<i>Exhibit B</i> , p. 4, ¶ 2; <i>Exhibit C</i> , p. 3, ¶3.
the plurality of check images include account-owner data elements linked to accounts maintained at non-participant institutions,	<i>Exhibit B</i> , p. 4, ¶ 2; <i>Exhibit C</i> , p. 3, ¶3; <i>Exhibit A</i> , p. 10.
each non-participant data element also corresponds to a data element field in the database;	<i>Exhibit B</i> , p. 4, ¶ 2; <i>Exhibit C</i> , p. 3, ¶3.
(c) populating the data element fields of the electronic account-owner verification database with the account-owner data elements linked to accounts maintained at the participant institutions and the non-participant institutions;	<i>Exhibit C</i> , p. 3, ¶¶2, 3; <i>Exhibit A1</i> , pp. 7, 10.
(d) entering into a computer system having the electronic account-owner verification database, for an account to be verified:	<i>Exhibit B</i> , p. 4, ¶ 4 – p. 5, ¶2; <i>Exhibit C</i> , p. 3, ¶5 – p. 4, ¶2.

(i) an account number; and	<i>Exhibit B</i> , p. 4, ¶ 4; <i>Exhibit C</i> , p. 3, ¶5; <i>Exhibit A</i> , p. 6.
(ii) at least one data element corresponding to the entered account number;	<i>Exhibit B</i> , p. 4, ¶ 4; <i>Exhibit C</i> , p. 4, ¶1.
(e) querying by the computer system the account-owner verification database which includes account-owner data linked to accounts maintained at both the participant institutions and the non-participant institutions;	<i>Exhibit B</i> , p. 4, ¶ 4; <i>Exhibit C</i> , p. 4, ¶1; <i>Exhibit A</i> , p. 10.
(f) transmitting by the computer system a response from the account-owner verification database for each of the entered data elements, wherein the response is positive for a given data element if the account-owner data stored in the data element field corresponding to the entered account number matches the entered data element, the response is negative for a given data element if the account-owner data stored in the data element field corresponding to the entered account number does not match the entered data element, or the response specifies that information is unavailable for a given data element if there is no account-owner data stored in the data element field corresponding to the entered account number; and	<i>Exhibit B</i> , p. 4 – p. 5, ¶ 3; <i>Exhibit C</i> , p. 4, ¶1-3; <i>Exhibit A</i> , p. 10.
(g) generating a report of the response.	<i>Exhibit B</i> , p. 5, ¶ 2; <i>Exhibit C</i> , p. 4, ¶2, 3;

*Exhibit A, p. 10.*

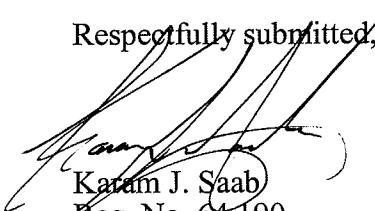
Therefore, because Weinflash was published after the instant claimed invention was invented, Weinflash does not qualify as §102(a) prior art. Accordingly, because Weinflash does not qualify under 102(a), 102(b), or 102(e) to be a reference, Weinflash is ineligible to serve as a reference.

For at least this reason, a *prima facie* case of obviousness is not present for the pending claims. Accordingly, Applicant respectfully requests withdrawal of the rejections of claims 1-4, 6-13 and 17.

**Conclusion**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested. Further, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment in connection with this paper to Deposit Account No. 20-1430. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

  
Karam J. Saab  
Reg. No. 64,190

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 303-571-4000  
Fax: 415-576-0300  
K4S:bhr  
62553076 v1